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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,213	06/20/2001	Stephan Kleier	3245-811	4610
7590	02/08/2005			EXAMINER
COHEN, PONTANI, LIEBERMAN & PAVANE Suite 1210 551 Fifth Avenue New York, NY 10176			ELAHEE, MD S	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/885,213	KLEIER ET AL
	Examiner Md S Elahee	Art Unit 2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,5,6,9-13,15-18,20,21 and 24-29 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,5,6,9-13,15-18,20,21 and 24-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 June 2001 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed on 11/22/2004. Claims 1, 3, 5, 6, 9-13, 15-18, 20, 21 and 24-29 are pending. Claims 2, 4, 8, 14, 19 and 23 have been cancelled.

### ***Response to Arguments***

2. Applicant's arguments have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the added limitations at this time.

### ***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because fig.8 and fig.10 are not formal drawings. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Objections***

4. Claims 5, 18-21, 24, 26 and 27 are objected to because of the following informalities: since claim 4 has been cancelled, claim 5 appears to be dependent on claim 1. Similarly, claims 18-21, 24, 26 and 27 appear to be dependent on claim 13. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 5, 6, 10-13, 15-17, 18, 20, 21, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Patent No. 6,505,040) and in view of Schuster et al. (U.S. Patent No. 6,577,622) and further in view of Wu (U.S. Patent No. 6,275,575).

Regarding claim 1, Kim teaches storing a list of multiple parties (i.e., a predetermined group of subscribers) (col.1, lines 66, 67, col.2, lines 1-10, 47-51).

Kim further teaches requesting, by a subscriber, the initiation of a telephone conference with the predetermined group of subscribers in the list by calling a telephone number not associated with any other subscriber in the list of a predetermined group of subscribers (col.2, lines 1-22, 47-56, col.3, lines 52-62).

Kim further teaches contacting, by a network element of the telecommunication network, the parties taken from the stored list of parties for preparing for setting-up a telephone conference between the parties in response to the step of requesting, the step of contacting comprising sending an invitation to the remote multiparty conference (i.e., telephone conference) to parties (i.e., subscribers) who are stored in the list (col.2, lines 1-22, 47-51).

Kim further teaches setting up the telephone conference by connecting those multiple parties that has connection confirmation, wherein the telephone conference is a mobile radio telephone conference in which at least one subscriber participates via a mobile radio network

(abstract; col.2, lines 1-22, 47-56). (Note: it is inherent that since the remote party answers the call, the network detects the connection establishment with the party, therefore, the inviter receives the connection confirmation)

However, it is not clear whether Kim teaches connecting only those subscribers that input an acceptance of the invitation. Schuster teaches connecting only those subscribers that input an acceptance of the invitation (fig.9A, 10A; col.20, line 29-col.21, line17, col.22, line 32-col.23, line15). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim to connect only those subscribers that input an acceptance of the invitation as taught by Schuster. The motivation for the modification is to have doing so in order to provide an indication of whether the subscribers desire to be conference participants.

Kim in view of Schuster fails to teach “transmitting the invitation as one of a short message service (SMS) message and WML content to the terminal”. Wu teaches transmitting the request (i.e., invitation) as one of a short message service (SMS) message and WML content to the terminal (col.6, lines 10-16, col.7, lines 13-25). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim in view of Schuster to transmit the invitation as one of a short message service (SMS) message and WML content to the terminal as taught by Wu. The motivation for the modification is to have doing so in order to provide a conventional means to deliver conference related text.

Regarding claims 3 and 18, Kim teaches requesting the telephone conference via a mobile radio telephone network (abstract; col.2, lines 1-22, 47-56).

Regarding claims 5 and 20, Kim teaches providing a limited number of mobile radio telephone numbers (IMSI) in at least one mobile radio telecommunication network, whereupon

when the numbers are called by any mobile radio subscriber, a telephone conference is set up to this mobile radio subscriber (col.2, lines 1-22, 47-56, col.3, lines 52-62).

Regarding claims 6 and 21, Kim teaches after a telephone conference has been requested by a subscriber, sending a message via a device at the mobile radio network end to the subscribers who are contained in the list for which list a telephone conference has been requested, and taking one of telephone numbers and other telecommunication identities of the subscribers from a list stored in one of the mobile radio network and by the subscriber requesting the telephone conference (col.2, lines 1-22, 47-56, col.3, lines 52-62).

Regarding claim 10, Kim teaches that the storing step includes storing, for the group, in each case a list of at least one of names, telephone numbers and other telecommunication addresses of only each subscriber in the group but no other subscriber in at least one of the mobile terminal, a mobile radio subscriber identification card and the telecommunication network (abstract; col.2, lines 1-22, 47-56).

Regarding claims 11 and 26, Kim teaches admitting only subscribers who are stored in a list for a group to a telephone conference for this group (abstract; col.2, lines 1-22, 47-56).

Regarding claims 12 and 27, Kim in view of Schuster fails to teach “defining a list with regard to subscribers contained therein by at least one of mobile radio Internet (WAP) and landline network Internet”. Wu teaches defining a list with regard to subscribers contained therein by at least one of mobile radio Internet (WAP) and landline network Internet (col.6, lines 66, 67, col.7, lines 1-12). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim in view of Schuster to define a list with regard to subscribers contained therein by at least one of mobile radio Internet (WAP) and landline

network Internet as taught by Wu. The motivation for the modification is to have doing so in order to facilitate intra-network communications.

Regarding claim 13 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Kim teaches a mobile phone to conference mode (i.e., control device) operative so that, when a telephone conference is requested for a multiple parties (i.e., a predetermined group of subscribers) by a party of a telecommunication network, the control device contacts parties of the predetermined group of parties, which parties are stored in a list for this group, for preparing the setting-up of a telephone conference between the parties (col.1, lines 66, 67, col.2, lines 1-10, 47-51).

Regarding claim 15, Kim in view of Schuster fails to teach “the control device includes an interface for receiving a request of a subscriber for setting up a telephone conference, and an interface for connecting subscribers to one another as a telephone conference”. Wu teaches that the control device includes an interface for receiving a request of a subscriber for setting up a telephone conference, and an interface for connecting subscribers to one another as a telephone conference (col.6, lines 10-16, col.7, lines 13-25). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim in view of Schuster to have the control device including an interface for receiving a request of a subscriber for setting up a telephone conference, and an interface for connecting subscribers to one another as a telephone conference as taught by Wu. The motivation for the modification is to have doing so in order to provide a conventional means to deliver conference related text.

Regarding claim 16, Kim teaches after the setting-up of the telephone conference has been prepared, a voice telephone conference is inherently established (col.1, lines 66, 67, col.2, lines 1-10, 47-51).

7. Claims 9, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Patent No. 6,505,040) and in view of Schuster et al. (U.S. Patent No. 6,148,068) and further in view of Wu (U.S. Patent No. 6,275,575) and further in view of Bradshaw, Jr. (U.S. Patent No. 6,608,820).

Regarding claims 9 and 24, Kim in view of Schuster further in view of Wu fails to teach “controlling a telephone conference with an element at the mobile radio network end during the telephone conference with regard to at least one of termination of the conference, exclusion of a subscriber from the conference and addition of a further subscriber, not contained in the list, to the conference”. Wu teaches controlling a telephone conference with an element at the mobile radio network end during the telephone conference with regard to at least one of termination of the conference, exclusion of a subscriber from the conference and addition of a further subscriber, not contained in the list, to the conference (abstract; col.4, lines 17-36). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kim in view of Schuster further in view of Wu to control a telephone conference with an element at the mobile radio network end during the telephone conference with regard to at least one of termination of the conference, exclusion of a subscriber from the conference and addition of a further subscriber, not contained in the list, to the conference as taught by Wu. The

motivation for the modification is to have doing so in order to make the required change to the number of participants in the conference.

Regarding claim 25, Kim teaches that for the group, in each case a list of at least one of names, telephone numbers and other telecommunication addresses of each subscriber of the group but no other subscribers is stored at least one of in the mobile terminal, in a mobile radio subscriber identification card and in a memory in the telecommunication network (abstract; col.2, lines 1-22, 47-56).

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sammon et al. (U.S. Patent No. 6,563,914) teach Personal web-based teleconferencing method and system.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703)305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703)305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. E.

MD SHAFIUL ALAM ELAHEE

February 6, 2005



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